



PATENT
29985/01-180

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Tracee E.J.
Eidenschink

Serial No.: 10/034,448

Filed: December 28, 2001

For: Hypotube with Improved Strain
Relief

Group Art Unit: 3763

Examiner: Roz Ghafoorian

I hereby certify that this paper and the documents referred to as enclosed therewith are being deposited with the United States Postal Service as first class mail, postage prepaid, on November 20, 2003, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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DEC 04 2003

Sir:

TECHNOLOGY CENTER R3700

In response to the restriction requirement imposed in the office action mailed on September 30, 2003, applicants provisionally elect Group I, with traverse. As set forth in detail below, applicants traverse this restriction requirement. Subject to that traversal and in accordance with the requirement of 37 C.F.R. § 1.143, applicants make the provisional election of Group I. Reconsideration and withdrawal of the restriction requirement is, however, requested in view of the following remarks.

The M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper; (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). In this instance, although the Office action argues that the groups of claims identified in the Office action are distinct, it fails to demonstrate that a serious burden would be placed on the Examiner if election were not required.

The applicants note that if there is a serious burden in the present application, it is on the applicant's assignee as a result of this restriction requirement. Unless the restriction requirement is withdrawn, the applicant's assignee must not only prosecute separate applications, which multiplies the cost of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain two different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

In summary, the Office action fails to address the second required criteria for restriction set forth in the M.P.E.P. In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). Therefore, applicant requests that the requirement for restriction be withdrawn. Moreover, because the restriction requirement is incomplete for failing to address the second requirement specified in the M.P.E.P., the applicant has not been afforded a fair opportunity to respond and the restriction requirement cannot properly be made "Final."

An early action on the merits of both groups of claims is earnestly solicited.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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November 20, 2003

By: _____

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